

**Request for Reconsideration:**

Claims 1-4 are pending in the above-captioned application, of which claim 1 is independent. Applicant is amending claim 1 to include subject matter of claim 2. Moreover Applicant is cancelling claim 2, without prejudice or disclaimer. No new matter is introduced by the amendment and this amendment is supported fully by the application as filed. E.g. Appl'n, Page 8, Line 23, through Page 9, Line 13; **Fig. 2**. Applicant respectfully requests that the Examiner reconsider the application in view of the following remarks.

**Remarks:**

1. Objections and Rejections.

Claim 1 stands rejected under 35 U.S.C. § 102(b), as allegedly anticipated by Patent No. US 5,588,807 A to Kimura et al. ("Kimura"). Further, claims 2 and 3 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Kimura in view of Patent No. US 6,149,398 A to Fukanuma et al. ("Fukanuma"); and claim 4 stands rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Kimura in view of Patent No. US 4,932,843 A to Itoigawa et al. ("Itoigawa"). Applicant respectfully traverses.

A. Anticipation Rejections.

As noted above, claim 1 stands rejected as allegedly anticipated by Kimura. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. . . . 'The identical invention must be shown in as complete detail as is contained in the . . . claim.'" MPEP 2131 (citations omitted). The Office Action asserts that Kimura discloses each and every element of claim 1. Applicant respectfully traverses.

Kimura describes a mechanical displacement control valve (25) wherein "[a] spherical valve body 28, disposed in a valve seat 29, normally abuts on the valve seat 27 by an urging spring 30 to close the communication passage 23A." Kimura, Col. 3 Lines 51-53 (emphasis added). Further, Kimura describes "[t]he actuation rod 33 is urged downward in a direction to move away from the valve body 28 by a spring 36 disposed between the valve assembly 26 and the spring seat 35." Kimura, Col. 3 Lines 60-63 (emphasis added). In contrast to the mechanical displacement control valve described in Kimura, amended claim 1 describes

“an electromagnetic displacement control valve.” Accordingly, Kimura fails to disclose the “electromagnetic displacement control valve” as set forth in amended claim 1. Therefore, at least for this reason, Applicant respectfully requests that the Examiner withdraw the anticipation rejection of claim 1.

B. Obviousness Rejections.

As noted above, claims 2 and 3 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Kimura in view of Fukanuma; and claim 4 stands rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Kimura in view of Itoigawa. In order to establish a prima facie case of obviousness, the Office Action must fulfill three (3) basic criteria. MPEP 2142 and 2143. First, there must be some clear and explicit articulation of the reason(s) why the claimed invention would have been obvious, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as proposed by the Office Action. Second, there must be a reasonable expectation of success. MPEP 2143.02. To satisfy this criterion, the Office Action must demonstrate that “one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.” MPEP 2143.02. Third, the cited references or in the knowledge generally available to those of ordinary skill in the art must disclose or suggest all of the claim limitations. MPEP 2142. As noted above, Applicant has amended claim 1 to include subject matter from claim 2. Applicant maintains that the amended claim 1 is not rendered obvious by Kimura in view of Fukanuma.

i. Independent Claim 1.

Claim 1, as amended, describes a common passageway configured such that

as said valve body is moved from a closed position to an open position, a gas flow occurs from said discharge chamber to said crank chamber through said common passageway, and when said valve body is in the closed position or the open position, a gas flow occurs from said crank chamber to said suction chamber through said common passageway.

The Office Action acknowledges that “Kimura does not disclose that a part of the common passageway is formed as a passageway through a bearing for a compressor main shaft.” Office

Action, Page 3, Lines 11-13. Nevertheless, the Office Action contends that “[i]t would have been obvious to a person having ordinary skill in the art to have modified the common passageway (24) of Kimura to have passed through the bearings of Kimura’s compressor shaft as taught by Fukanuma to lubricate the bearings with oil carried by the compressor gas.” Office Action, Page 4, Lines 3-6. Applicant respectfully traverses.

Referring to Applicant’s **Fig. 2**, as valve body 5a moves from its closed position against communication passageway 1d to an open position within valve chamber 6 and before pressure sensing rod 4 seals communication passageway 1d, gas may flow from discharge chamber 64 to crank chamber 55. Page 8, Line 23, through Page 9, Line 13. This flow path is not available when valve body 5a is in the open or closed position.

Neither Kimura nor Fukanuma discloses or suggests a structure wherein “a gas flow occurs from said discharge chamber to said crank chamber” as the valve body is moved in its opening direction from a closed position to an open position, and wherein “a gas flow occurs from said crank chamber to said suction chamber through said common passageway” when the valve body is in the closed or open position as described in amended claim 1. Consequently, Applicant maintains that the Office Action fails to demonstrate that Kimura in view of Fukanuma discloses or suggests all of the limitations of amended, independent claim 1. Therefore, amended claim 1 is not rendered obvious by this combination of references despite the inclusion of the subject matter of claim 2.

ii. Dependent Claims 3 and 3.

Claims 3 and 4 depend from amended, independent claim 1. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP 2143.03 (citations omitted). Therefore, at least for this reason, and in view of the foregoing remarks with regard to amended claim 1, Applicant respectfully requests that the Examiner withdraw the obviousness rejection of claims 3 and 4.

**Conclusion:**

Applicant maintains that the above-captioned patent application, as amended, is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution of this application may be furthered by discussing the application, in person or by telephone, with Applicant's representatives, Applicant's representatives would welcome the opportunity to do so. Applicant believes that, with the exception of the fees for a one-month extension of time to respond, no additional fees are due as a result of filing this responsive amendment. Nevertheless, in the event of any variance between the fees determined by Applicant and the fees determined by the PTO, please charge or credit any such variance to the undersigned's **Deposit Account No. 02-0375**.

Respectfully submitted,  
BAKER BOTTS L.L.P.

Dated: **June 1, 2010**

By: 

James B. Arpin  
Registration No. 33470

Baker Botts L.L.P.  
The Warner; Suite 1300  
1299 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004-2400  
(202) 639-7700 (telephone)  
(202) 639-7890 (facsimile)

JBA/djw